Supreme Court, U.S.
FILED
JUN 15 2007
OFFICE OF THE CLERK

No. 06-1372

IN THE

SUPREME COURT OF THE UNITED STATES

RICHARD W. BERGER AND BRANT W. BERGER,

Petitioners,

v.

ROSSIGNOL SKI COMPANY, INCORPORATED,

Respondent

On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION

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RULE 29.6 CORPORATE DISCLOSURE STATEMENT

The parent corporations of Respondent Rossignol Ski Company, Inc. are Quiksilver Americas, Inc. and Quiksilver, Inc. Respondent is 100% owned by Quiksilver Americas, Inc., which in turn is 100% owned by Quiksilver, Inc., a publicly traded company.

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OPINIONS AND ORDERS BELOW

The January 12, 2007 Judgment (Order of Affirmance) of the Court of Appeals for the Federal Circuit (Pet. App. A) is reported at 2007 WL 200935. The March 21, 2006, April 25, 2006 and July 16, 2006 Orders/Opinions of the U.S. District Court for the Northern District of California (A732-35 and Pet. App. C and B) are reported at 2006 WL 708943, 2006 WL 1095914 and 2006 WL 2038324, respectively.[1]

INTRODUCTION: SUMMARY OF REASONS FOR DENYING THE PETITION

This case does not merit review, and the Petition should therefore be denied, for at least four reasons.

First, the Petition does not present any compelling reason for review on certiorari as required by this Court's Rule 10. Rather, the Petition merely alleges that the district court's application of its Patent Local Rule requirements with respect to patent infringement contentions deprived Petitioners (supposed "modest means inventors") of a patent infringement trial, a misguided allegation that could be made in any case decided before trial.

Second, the arguments relied upon in the Petition were not raised below and are therefore waived. More particularly, Petitioners did not argue, before the district court or the Federal Circuit, alleged conflict between Judge Breyer's application of the district court's Patent Local Rules and Fed. R. Civ. P. 8, 15(b) and 83(a)(2).

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[1] "Pet." or "Petition" refers to the Petition for a Writ of Certiorari. "A__" refers to the Joint Appendix of record before the Court of Appeals for the Federal Circuit.

Third, the alleged rules conflict is non-existent. The Local Patent Rules, and Judge Breyer's application of them in this case, relate to matters that are distinct from -- and thus are not possibly inconsistent with -- the matters addressed by Fed. R. Civ. P. 8, 15(b) and 83(a)(2). The Patent Local Rules address submission and amendment of post-pleading patent infringement contentions, whereas Fed. R. Civ. P. 8 and 15(b) set forth requirements with respect to pleadings (and amendments to pleadings) and Fed. R. Civ. P. 83(a)(2) concerns nonwillful failures to comply with local rules imposing requirements of form. Accordingly, there likewise is no possible violation of Fed. R. Civ. P. 83(a)(1) due to any inconsistency between the local and federal rules, as alleged.

Fourth, the Petition includes numerous misstatements of fact and law. Thus, the Petition does not even present an accurate portrayal of this case for the Court's consideration.

STATEMENT OF THE CASE[2]

There is nothing about this case that warrants this Court's review of the judgment below in favor of Respondent ("Rossignol"). As the following facts of record establish, Petitioners (the "Bergers") belatedly served their infringement contentions, as required by the district court's Patent Local Rules, after having had literally years to deliberate. Rossignol relied upon those infringement contentions in preparing and serving invalidity contentions under the Patent Local Rules and in preparing and filing a motion for summary judgment. Weeks after Rossignol filed its motion, the Bergers moved to amend their infringement

[2] In compliance with this Court's Rule 15.2, the Petition's numerous misstatements of fact and law are addressed here and/or in the Argument portion of this Opposition Brief below.

contentions to avoid summary judgment, but failed to show good cause for doing so. Thus, Judge Breyer correctly denied the motion to amend, granted summary judgment of noninfringement, entered judgment for Rossignol, and confirmed that judgment in the course of denying the Bergers' motion to vacate. The Federal Circuit correctly affirmed. At no time did either court take any action in violation of Fed. R. Civ. P. 8, 15(b) or 83(a)(2), and the Bergers did not so argue until their Petition to this Court.

A. Petitioners Had Years To Develop Their Infringement Contentions

The Bergers first contacted Rossignol in April 1998, alleging Rossignol's use of the Bergers' purported snowboard binding invention leading to U.S. Patents Nos. 5,913,530 and 6,196,569 (530 and 569 patents, respectively). (Pet. App. C, p. 10a; A195-98, ¶¶2-3; A200-01). After a series of letters and meetings between the parties, Rossignol wrote to the Bergers on May 6, 1999, explaining why Rossignol's products would not infringe the Bergers' alleged patent rights and forwarding a sample of Rossignol's products "to make sure that you have a good understanding of our product." (Pet. App. C, pp. 10a-11a; A195-98, ¶¶4-5; A207-37).[3]

The Bergers never responded to Rossignol's May 6, 1999 letter. Rather, on June 21, 2005 (not June 2006 as stated at Pet. 8), after over six years of silence and inaction by the Bergers, the Bergers brought suit against Rossignol in the Northern District of California for alleged infringement of the 530 and 569 patents. (Pet. App. C, p. 11a; A5; A195-98, ¶6).

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[3] The Petition mischaracterizes the origin of Rossignol's accused snowboard binding and the nature of the alleged invention compared to the prior art. *See* Argument Part IV below, ¶¶ 4-5.

Although the Bergers filed this case in June 2005, they did not serve Rossignol until October 4, 2005, more than three months later, after amending their Complaint as a matter of course. (A5; A52-54; A97-101, ¶¶2-3; A195-98, ¶6). On November 18, 2005, District Court Judge Breyer held a case management conference. (Pet. App. C, p. 11a; A7). At the conference, the Bergers' attorney, Mr. Allen (who filed the Petition with this Court), acknowledged that he was behind on some tasks in the case (including, *e.g.*, serving the Bergers' initial disclosures), and indicated to Rossignol's attorneys that he was meeting later that day with other attorneys, including Mr. Slobodin, to discuss matters. (A97-101, ¶10; A665-68, ¶7; A1003-04, ¶2). At Mr. Allen's request, Judge Breyer granted the Bergers leave to amend their Complaint a second time in accordance with Fed. R. Civ. P. 15, which they subsequently did. (A7; A77-80).

According to the district court's Patent Local Rule 3-1 (Pet. App. D), the Bergers' infringement contentions were to be served within 10 days of the case management conference. However, despite repeated requests from Rossignol following the case management conference, the Bergers did not serve their infringement contentions until January 4, 2006, after Rossignol moved to compel them. (Pet. App. C, pp. 11a-12a; A8; A97-101, ¶¶12-15; A602-05, ¶8). Thus, over and above the many months since the case had been filed, and the many years before the case was filed, the Bergers had yet an additional month to prepare and serve their infringement contentions at a time when both Mr. Allen and Mr. Slobodin were involved in the case on behalf of the Bergers.

B. Petitioners' Belated Infringement Contentions Were Detailed And Deliberate

The Bergers' infringement contentions (A239-54) asserted literal infringement (not infringement under the doctrine of equivalents) of independent claim 1 and several dependent claims of the pleaded 530 patent (and no claims of the pleaded 569 patent) by an illustrated Rossignol snowboard binding (the "accused binding"). The Bergers' infringement contentions included various photographs of Rossignol's accused binding, and identified various parts of the binding as allegedly corresponding to elements of the Bergers' asserted claims.

The independent claim asserted by the Bergers recited a binding that included, *inter alia*, "a boot comprising an upper attachment" and "a lower attachment connectable to a board." (A45; A241). The Bergers' infringement contentions explained in detail, with respect to the asserted claims, that (1) the upper attachment in Rossignol's accused binding was a plate fixed to the boot, and (2) the lower attachment in Rossignol's accused binding was an assemblage, connected to the snowboard, including a rotatable base (labeled no. 4 in the Bergers' photographs). (A241-43 and A245). With respect to the rotatable base 4, the Bergers' infringement contentions stated, for example, that "Lower attachment includes 4 ...." (A243).

Thus, Petitioners did not "[p]lac[e] a component number in the wrong box," and thus provide a "mere misidentification of a component part," in their infringement contentions. (Pet. 5, 8, 10). Moreover, Petitioners' infringement contentions did not constitute a "requirement of form" or a "mere local rule technicality." (Pet. 6, 7, 9, 10). Rather, after having had years to deliberate, Petitioners appropriately explained -- in their substantive infringement

contentions -- that Rossignol's binding assemblage connected to the snowboard, including rotatable base 4, constituted the claimed "lower attachment connectable to a board." (A239-54).

C. Rossignol's Invalidity Contentions And Summary Judgment Motion Relied Upon Petitioners' Infringement Contentions

Based in significant part on the Bergers' infringement contentions, Rossignol prepared and served detailed invalidity contentions on February 17, 2006 as required by Patent Local Rule 3-3, and filed and served a motion for summary judgment of unenforceability (equitable estoppel), noninfringement and invalidity on February 21, 2006. (Pet. App. C, p. 12a; A8; A128-58; A1399-1401). In each of these documents, Rossignol specifically pointed out that the Bergers had asserted only certain claims of the 530 patent and no claims of the 569 patent. (A135 n. 1; A1004, ¶3; A1005-07, n. 1).

In response to the request of the Bergers' attorney, Mr. Allen, to move the original March 31 summary judgment motion hearing date in view of Mr. Allen's vacation schedule (which hearing was moved by agreement of the parties to April 14), Mr. Allen and Rossignol's attorneys had several discussions regarding the motion. During this period of time, Mr. Allen did not indicate that the Bergers intended to amend their infringement contentions, and he did not take any action to do so. (Pet. App. C, pp. 12a, 16a; A8-10; A583-84; A665-68, ¶¶2-7).

D. Petitioners' Actions In Response To Rossignol's Summary Judgment Motion

The Bergers' other attorney, Mr. Slobodin, finally filed a formal appearance on March 14, 2006, despite having been involved in the matter since at least November 2005 according to his co-counsel, Mr. Allen. (Pet. App. C, pp. 12a, 16a-17a; A9; A652-53; A665-68, ¶7; A1003-04, ¶2). The Bergers then moved on March 15, 2006 to defer Rossignol's summary judgment motion, based, *inter alia*, on an alleged need for discovery. (A9; A655). On March 21, 2006, Judge Breyer issued an order denying the Bergers' motion to defer, setting an extended briefing schedule on Rossignol's summary judgment motion, and confirming that the summary judgment hearing would go forward on April 14 as scheduled. (Pet. App. C, p. 12a; A10; A732-35). Judge Breyer's order reflected the fact that the Bergers had not sought to take any discovery despite the passage of over four months since the case management conference, and had not specified what discovery was allegedly needed with respect to Rossignol's summary judgment motion. (A733-34). After Judge Breyer denied their motion to defer, the Bergers then filed a motion to amend their infringement contentions and an opposition to Rossignol's summary judgment motion on March 27, 2006. (A10-10A).

In their motion to amend, the Bergers sought to substantially recast their infringement contentions in view of Rossignol's summary judgment motion that had been filed over a month earlier. (Compare A239-54 with A747-54; see also A998-1000). For example, the Bergers proposed, *inter alia*, to newly assert a claim of the 569 patent, change the group of asserted 530 patent claims, assert the doctrine of equivalents, change what they asserted to be the lower attachment in Rossignol's accused binding, reverse what they asserted to be a coupling mount and coupler in Rossignol's

accused binding, and change their positions regarding various ones of the dependent claims. (*Id.*).

The Bergers' primary justification for seeking to amend their infringement contentions was that their attorney who prepared the contentions, Mr. Allen, was "not experienced patent counsel" (A761, ¶1) and "made errors in" the infringement contentions (A762, ¶3; also A736). The Bergers further contended that the need to amend their infringement contentions became apparent after (1) Rossignol filed its summary judgment motion, (2) the Bergers retained additional counsel, Mr. Slobodin, and (3) the Bergers conducted further discovery, evaluation, investigation and/or research, including evaluation of the physical binding. (A762, second ¶4). The Bergers also asserted that amendment was supported by the inclusion in their contentions of a boilerplate qualifying statement that they were subject to revision. (A762, first ¶4).

The Bergers' defense to summary judgment of noninfringement based on one of several missing claim features -- the absence in Rossignol's accused binding of "rotation of the upper attachment relative to the lower attachment" as required by 530 patent claim 1 (Pet. App. C, p. 20a) -- depended upon the Bergers being permitted to amend their infringement contentions. The Bergers stated in their summary judgment opposition brief that, "[u]nder the correct infringement contention, where the coupler base [rotatable base 4] is not part of the lower attachment [contrary to the Bergers' infringement contentions but in accordance with their proposed amended contentions], the 'rotation [o]f the upper attachment relative to the lower attachment limitation' is fulfilled." (Pet. App. C, p. 21a; A797).

E. Judge Breyer's April 25, 2006 Memorandum And Order

1. Denial Of Petitioners' Motion To Amend For Lack Of Good Cause

In ruling on the Bergers' motion to amend on April 25, 2006, Judge Breyer stated that "[t]he critical issue is whether plaintiffs have shown good cause for amending their infringement contentions," as required by Patent Local Rule 3-7. (Pet. App. C, pp. 10a and 13a). Judge Breyer thoroughly considered at least five factors before denying the Bergers' motion to amend for lack of good cause.

First, Judge Breyer thoroughly assessed Mr. Allen's declaration accompanying the Bergers' motion to amend. He determined that Mr. Allen's declaration failed to establish good cause, because it failed to explain why the alleged "errors" were made, how Mr. Allen and his clients could have "mistakenly" omitted any contentions as to the 569 patent, or why they delayed in moving to amend their contentions. (Pet. App. C, pp. 15a-16a). He concluded that Mr. Allen's declaration at most established carelessness or mere errors that were insufficient to establish good cause. (*Id.*, pp. 18a-19a).

Second, Judge Breyer held that the Bergers' boilerplate qualification of their infringement contentions was immaterial. He noted that a party cannot unilaterally amend the Patent Local Rules. (Pet. App. C, p. 16a).

Third, Judge Breyer concluded that the Bergers were not diligent in seeking to amend their infringement contentions. He noted that the Bergers did not move to amend their infringement contentions when the Bergers received Rossignol's invalidity contentions, or even later

when the Bergers received Rossignol's summary judgment motion, but rather waited until after he denied their motion to defer Rossignol's summary judgment motion. (Pet. App. C, p. 16a). He also noted that the Bergers' delay in this regard came on the heels of their several-week delay in filing their infringement contentions following their over seven-year delay in filing suit after first accusing Rossignol of infringement. (*Id.*, pp. 16a and 18a).

Fourth, Judge Breyer held that Petitioners' addition of co-counsel (Mr. Slobodin) did not provide good cause. He noted in this regard that Petitioners had been conferring with Mr. Slobodin for months prior to his formal appearance in the case. (Pet. App. C, pp. 16a-17a).

Fifth, Judge Breyer concluded that Rossignol would be prejudiced if he were to permit the Bergers to amend their infringement contentions. He indicated that Rossignol had relied upon the Bergers' infringement contentions and incurred substantial costs in preparing Rossignol's invalidity contentions and summary judgment motion. He also indicated that permitting amendment would further delay resolution of the case, "which has already been delayed due to plaintiffs' unwillingness to comply with the Local Rules." (Pet. App. C, p. 17a).

Judge Breyer ultimately determined that the Bergers had failed to establish good cause to amend their infringement contentions, even if the Bergers had promptly sought leave to amend the contentions, which they had not. He concluded that "plaintiffs offer so little explanation that to permit amendment here would render the 'good cause' requirement meaningless." (Pet. App. C, p. 19a).

Thus, Judge Breyer did not deny the motion merely because of Petitioners' lack of diligence. (Pet. 8). He also

did not "[f]ail[] to consider whether the mistake of counsel has prejudiced the defense" (Pet. 10), and certainly did not observe that "no prejudice" or "no measurable prejudice" would occur if the motion was granted (Pet. 1, 8-9). Rather, Judge Breyer considered diligence, prejudice and all of the other circumstances consistent with Petitioners' cited case of *Pioneer Investment Services Co. v. Brunswick Assoc. Ltd. Partnership*, 507 U.S. 380 (1993) (Pet. 9), including Petitioners' failures to explain how their alleged errors occurred and to otherwise justify their requested amendment. He then correctly concluded that (1) the Bergers had not shown good cause for amending their infringement contentions and (2) Rossignol would be prejudiced if Petitioners were permitted to amend. (Pet. App. C, pp. 13a-19a; Pet. App. B, pp. 5a-7a).

2. Grant Of Rossignol's Motion For Summary Judgment

In granting summary judgment of noninfringement in Rossignol's favor, Judge Breyer acknowledged that the Bergers pleaded infringement of both the 530 and 569 patents, but asserted in their infringement contentions infringement of only specified claims of the 530 patent and no claims of the 569 patent. (Pet. App. C, p. 9a). With respect to the asserted claims, he considered the Bergers' infringement contentions and accompanying illustrations of Rossignol's accused binding that labeled the boot plate as the "upper attachment" and the assemblage on the snowboard (including rotatable base 4) as the "lower attachment." (*Id.*, pp. 20a-21a). He compared asserted independent claim 1 to Rossignol's accused binding and held that there is no literal infringement because the alleged "upper attachment" in Rossignol's binding does not rotate relative to the alleged "lower attachment" as expressly required by the claim (*i.e.*,

rotatable base 4 rotates with, not relative to, the boot plate). (*Id.*, pp. 19a-22a).

Because the remainder of the asserted claims depend directly or indirectly from claim 1, Judge Breyer also held that the asserted dependent claims are not infringed. (Pet. App. C, p. 21a). His order did not address the doctrine of equivalents because, as noted above, the Bergers' infringement contentions did not assert infringement under the doctrine of equivalents as required by the district court's Patent Local Rule 3-1(d). (*See* A239-54).

The Petition erroneously implies that Judge Breyer did not consider evidence outside the pleadings in ruling on Rossignol's summary judgment motion, and erroneously states that "plaintiffs were denied an adjudication on the merits" because, allegedly, "[t]here was no comparison of plaintiffs' claims to the accused device, independent of the erroneous claims chart." (Pet. 9; *see also* Pet. 1, 7, 10). To the contrary, the parties' summary judgment papers included a total of nearly 40 exhibits, including fact witness declarations and other information relating, *inter alia*, to the issue of infringement/noninfringement. (A8; A10A; A134; A767; A824 and A849). Moreover, in granting summary judgment of noninfringement on the merits, Judge Breyer compared Petitioners' asserted claims to the accused device, while considering the appropriateness of Petitioners' characterization of the accused device in their infringement contentions. (Pet. App. C, pp. 19a-22a; Pet. App. B, p. 4a).

F. Petitioners' Motion To Vacate Judgment And Judge Breyer's July 16, 2006 Order Denying The Motion

On May 23, 2006, nearly a month after Judge Breyer's April 25 order and one day before the Bergers

appealed to the Federal Circuit, the Bergers moved under Fed. R. Civ. P. 60(b) to vacate Judge Breyer's judgment that was based on his April 25 order. (A10D). The Bergers relied upon both old and new arguments (including the general proposition that local court rules must be consistent with the Federal Rules of Civil Procedure), but did not argue a conflict between the district court's application of its Patent Local Rules and Fed. R. Civ. P. 8, 15(b) and 83(a)(2). (A1178-96). On July 16, 2006, after the motion was fully briefed, Judge Breyer denied the motion, thereby confirming his judgment and April 25 order. (Pet. App. B). More particularly, he indicated in his July 16 order, *inter alia*, that "plaintiffs' assertion of an 'inadvertent' mistake is contradicted by the sequence of events as well as the declaration of their own counsel." (*Id.*, p. 7a; *see also* pp. 5a-6a).

G. Petitioners' Federal Circuit Appeal

The Bergers appealed to the Federal Circuit. The Bergers again relied upon both old and new arguments (including the general requirement for consistency between local and federal rules), but did not argue a conflict between the district court's application of its Patent Local Rules and Fed. R. Civ. P. 8, 15(b) and 83(a)(2). (*See* the Bergers' Federal Circuit briefs). After briefing and oral argument, the Federal Circuit (Chief Judge Michel and Circuit Judges Gajarsa and Dyk) affirmed Judge Breyer's judgment. (Pet. App. A).

ARGUMENT: REASONS FOR DENYING THE PETITION

I. The Petition Presents No Compelling Reason For Review On Certiorari As Required By This Court's Rule 10

This Court's Rule 10 reflects "the character of the reasons the Court considers" in reviewing a petition for a writ of certiorari. The instant Petition does not even refer to Rule 10, much less present for the Court's consideration any reason of the magnitude of those set forth in Rule 10 that would warrant this Court's review of this case.

Indeed, the Petition's "Question Presented" (Pet. *i*), like the rest of the Petition, does nothing more than allege that the district court's application of its Patent Local Rule requirements with respect to patent infringement contentions deprived Petitioners of a patent infringement trial, a misguided allegation that could be made in any case decided before trial. This does not amount even to an allegation "of erroneous factual findings or the misapplication of a properly stated rule of law," for which "[a] petition for a writ of certiorari is rarely granted." Supreme Court Rule 10.

Nor does the Petition's purported plea on behalf of "modest means inventors" (Pet. *i*, 3) present a reviewable question for this Court. As explained in the Petition's cited case of *Weibrecht v. Southern Illinois Transfer, Inc.*, 241 F.3d 875, 880 (7th Cir. 2001), the fact that a local rule might impose additional requirements and thereby raise the cost of pursuing a right under a federal law does not present a conflict between the local rule and the federal law. Moreover, at least in *Weibrecht* there was an arguable conflict between the federal law and the local rule there in issue (*i.e.*, the federal law prohibited devices that prevent

common carrier employees from voluntarily furnishing information concerning employee injuries and death, and the local rule required a lawyer to go through such employees' lawyers to obtain such information). By contrast, the Petition in this case does not present even an arguable conflict between federal and local rules, as discussed below.

II. The Petition Relies Upon Arguments That Were Not Raised Below And Are Thus Waived

Although Petitioners generally argued below that local rules must be consistent with the Federal Rules of Civil Procedure, Petitioners did not argue to the district court or the Federal Circuit that the district court's Patent Local Rules, or Judge Breyer's application of them in this case, were allegedly in conflict with Fed. R. Civ. P. 8, 15(b) or 83(a)(2), upon which Petitioners now primarily rely. (*E.g.*, *compare* A1178-96 (motion to vacate judgment) and Petitioners' Federal Circuit briefs with Pet. 3, 6-7). Accordingly, Petitioners' arguments are waived. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____, 127 S. Ct. 1727, 1744 (2007) ("In light of Teleflex's failure to raise the argument in a clear fashion, and the silence of the Court of Appeals on the issue, we take the District Court's conclusion on the point to be correct."); *Travelers Casualty & Surety Co. of America v. Pacific Gas & Electric Co.*, 127 S. Ct. 1199, 1207 (2007) ("we ordinarily do not consider claims that were neither raised nor addressed below"); *Bath Iron Works Corp. v. Director, OWCP*, 506 U.S. 153, 162 n.12 (1993) ("Petitioners did not raise the issue below and the Court of Appeals considered it waived.... We do as well.").

III. The Petition Relies Upon Irrelevant Arguments That Do Not Present A Conflict Between The District Court's Patent Local Rules And The Federal Rules Of Civil Procedure

The Petition asserts a violation of Fed. R. Civ. P. 83(a)(1) by reason of alleged inconsistency between the district court's Patent Local Rules (and their application) and Fed. R. Civ. P. 8, 15(b) and 83(a)(2). (*E.g.*, Pet. 3 and 6-7). However, the Petition presents no viable example of any such inconsistency. As discussed below, the district court's Patent Local Rules, and Judge Breyer's application of them in this case, relate to matters that are distinct from -- and thus are not possibly inconsistent with -- the matters addressed by Fed. R. Civ. P. 8, 15(b) and 83(a)(2).

A. Fed. R. Civ. P. 83(a)(1)

Fed. R. Civ. P. 83(a)(1) expressly states that "[a] local rule shall be consistent with -- but not duplicative of --" federal rules. Additionally, Fed. R. Civ. P. 83(b) states that "[a] judge may regulate practice in any manner consistent with" both federal and local district court rules.

Those statements describe precisely the district court's Patent Local Rules and their application in this case by District Court Judge Breyer. As discussed below, the Patent Local Rules are consistent with and not duplicative of Fed. R. Civ. P. 8, 15 and 83(a)(2), and Judge Breyer merely regulated practice consistent with both the federal civil rules and the district court's Patent Local Rules. Thus, the Petition presents no possible basis for a violation of Fed. R. Civ. P. 83(a)(1).

B. Fed. R. Civ. P. 83(a)(2)

Fed. R. Civ. P. 83(a)(2) relates to matters of "form" and "technicality," as reflected by its express provisions (and admitted by Petitioners). (Fed. R. Civ. P. 83(a)(2); Pet. 3, 6, 9-10). Moreover, Fed. R. Civ. P. 83(a)(2) is only potentially implicated in the event of a non-willful failure to comply with a requirement of form. (*Id.*). Neither condition exists in this case.

As is evident from even a quick perusal of Patent Local Rule 3-1 (Pet. App. D, pp. 24a-25a), the infringement contentions required by the Patent Local Rules are a matter of substance, not "form" or "technicality" as alleged (but not demonstrated) by Petitioners. (Pet. 6, 7, 9, 10). Infringement contentions are likewise not merely "a vehicle to assist the Court in identifying which claims in the patent apply to the accused infringing device." (Pet. 4). Rather, infringement contentions under the Patent Local Rules serve to provide the district court and the accused infringer with detailed information with respect to a patentee's assertion of infringement. For example, Patent Local Rule 3-1 requires the infringement contentions to (a) identify each patent claim allegedly infringed, (b) separately identify for each asserted claim, "as specific as possible," each accused apparatus, product, device, process, method, act, or other instrumentality, (c) provide a chart identifying specifically where each element of each asserted claim is found within each accused instrumentality, (d) indicate whether asserted infringement is alleged to be literal or under the doctrine of equivalents, (e) identify the priority date to which each asserted claim allegedly is entitled, and (f) identify the patentee's own products, processes, etc. that are allegedly encompassed by the asserted claims. (Pet. App. D, pp. 24a-25a).

The types of things that have been held to be matters of form are minor formatting or procedural requirements, not disclosures of substantive information and positions. Conversely, things even approaching substance *(e.g.*, deadlines and other requirements for opposing summary judgment) have been held not to be matters of form. In this regard, *see, e.g., Cornett v. Weisenburger*, 454 F.Supp.2d 544, 551-52 (W.D. Va. 2006) (local rule requirements to pay filing fee upon filing complaint and to follow precise format for filing by facsimile are matters of form); *El-Kaissi v. Martinaire, Inc.*, 2005 WL 2897055 *6 (S.D. Tex. 2005) ("rules of form are just that - rules that require court submissions to be in a certain form," and thus local rule deadline for filing a response to a summary judgment motion is not a matter of form); *Loggins v. Franklin County*, 2005 WL 1705187 *3 (S.D. Ohio 2005) (deadline for submitting evidence in opposition to summary judgment motion was not a matter of form); and *Cordray v. 135-80 Travel Plaza, Inc.*, 356 F.Supp.2d 1011, 1015 n.6 (D. Neb. 2005) (local rule requirement to authenticate documents offered in opposition to summary judgment motion was not a matter of form).

Additionally, a statement in an infringement contention does not constitute a non-willful failure to comply with the requirement for infringement contentions. Understandably, Petitioners did not (and could not) show otherwise in their Petition.

Thus, Judge Breyer's denial of Petitioners' motion to amend their infringement contentions for lack of a showing of good cause, and his grant of Rossignol's motion for summary judgment of noninfringement based, *inter alia*, upon Petitioners' infringement contentions, did not conflict with the provision in Fed. R. Civ. P. 83(a)(2) that "[a] local rule imposing a requirement of form shall not be enforced in a manner that causes a party to lose rights because of a

nonwillful failure to comply with the requirement." (Emphasis added). Accordingly, Judge Breyer's application of the Patent Local Rules in this case did not violate Fed. R. Civ. P. 83(a)(1) by reason of any inconsistency with Fed. R. Civ. P. 83(a)(2).

C. Fed. R. Civ. P. 8 and 15

Fed. R. Civ. P. 8 governs pleadings, not substantive submissions subsequent to pleadings. Thus, Rule 8 does not govern submission of infringement contentions following a case management conference as required by the district court's Patent Local Rule 3-1.

Likewise, Fed. R. Civ. P. 15 relates to amendments to pleadings, not amendments to substantive submissions such as infringement contentions. Judge Breyer therefore correctly found that Patent Local Rule 3-7, not the "generally lenient" pleading amendment provisions of Fed. R. Civ. P. 15, governed Petitioners' motion to amend their infringement contentions. (Pet. App. C, pp. 13a-14a).

Thus, the district court's Patent Local Rules do not impose requirements with respect to a party's pleadings, but rather impose requirements with respect to a party's post-pleading disclosures. Accordingly, contrary to Petitioners' assertion (Pet. 3, 6-7), Judge Breyer's application of the Patent Local Rules did not conflict with the provisions of Fed. R. Civ. P. 8 or 15 relating to pleadings and amendments to pleadings.[4] For the same reason, the Petition's cited cases of *Swierkiewicz v. Sorema N.A.*, 534 U.S. 506 (2002), and

[4] Indeed, in accordance with Fed. R. Civ. P. 15, Judge Breyer permitted Petitioners to amend their Complaint a second time after they had amended it once before as a matter of course. (A5; A7; A52-54; A77-80).

Jones v. Bock, 549 U.S. ___, 127 S. Ct. 910 (2007) (Pet. 6 and 9), are inapplicable, as both cases addressed issues relating to the sufficiency of complaints (not post-pleading disclosures) given lower courts' impositions of specific pleading requirements over and above those required by Fed. R. Civ. P. 8(a).

IV. The Petition Includes Numerous Additional Misstatements of Fact and Law

In compliance with its obligation under this Court's Rule 15.2, Respondent Rossignol addresses, as follows, the Petition's misstatements of fact and law beyond those addressed above:

1. The Petition mischaracterizes the Federal Circuit's decision in *O2 Micro Int'l Ltd. v. Monolithic Power Systems, Inc.*, 467 F.3d 1355 (Fed. Cir. 2006). The Petition erroneously states with respect to that case that "[i]n reviewing motions for leave to amend infringement contentions, the Federal Circuit has determined that the District Court shall consider only the diligence, or lack thereof, of the moving party [the Bergers in the instant case] without regard to considerations of prejudice to responding party [Rossignol in the instant case]." (Pet. 4). The Federal Circuit merely ruled in *O2 Micro* that, under the specific circumstances at issue in that case, including "O2 Micro's delay in moving to amend its infringement contentions and its lack of adequate explanation for this delay" resulting in the district court's "finding a lack of diligence and therefore a lack of 'good cause,'" the Court saw no need to consider the question of prejudice to Monolithic Power Systems. *Id.* at 1367-68. In any event, the case is irrelevant to the instant case in which Judge Breyer, in ruling on Petitioners' motion to amend their infringement contentions, considered

prejudice and other circumstances in addition to diligence. (*See again* Pet. App. C, pp. 13a-19a; Pet. App. B, pp. 5a-7a).

2. The Petition mischaracterizes this Court's decision in *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), as supposedly requiring "the Court to consider evidence, not pleadings" in conjunction with a summary judgment motion. (Pet. 9-10). As *Celotex* held, in a case such as this where a summary judgment motion is directed to an issue (alleged infringement) as to which the non-moving party (the Bergers) has the burden of proof, "a summary judgment motion may properly be made in reliance solely on the 'pleadings, depositions, answers to interrogatories, and admissions on file.' " *Id.* at 324. The non-moving party (the Bergers) must then go beyond the pleadings to demonstrate a genuine issue for trial, *id.*, which the Bergers did not do in this case.

3. Citing this Court's decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), the Petition implies that a separate "*Markman*" claim construction hearing must be conducted. (Pet. 8). This Court's *Markman* decision includes no such requirement. Furthermore, the Federal Circuit's underlying decision, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 981 (Fed. Cir. 1995) (affirmed by this Court's decision), states that a court may conduct claim construction, *e.g.*, "in the context of dispositive motions such as those seeking judgment as a matter of law."

4. There is nothing in the record to support the Petition statement that Rossignol's accused binding was developed "after Rossignol representatives photographed plaintiffs' binding at a trade show." (Pet. 7). Richard Berger's declaration addressing the trade show in question did not state/contend that Rossignol representatives

photographed the Bergers' binding. (*See* A824-25). Moreover, an uncontested declaration in the record establishes that the company Emery developed the accused binding without any knowledge of the Bergers' binding. (A869-910).

5. The snowboard binding disclosed and claimed in Petitioners' patents is not "[u]nlike all other snowboard bindings" in allegedly being "a binding that can be adjusted by rotation of the foot, without tools, while the snowboarder is still attached to the snowboard." (Pet. 7). The prior art included snowboard bindings that could be adjusted by rotation of the foot, without tools, while the snowboarder remained attached to the snowboard. (*E.g.*, A153-54; A156; A256; A322-88; A390; A401-12; A467-72; A479; A497; A563-66; A920-31 and A933-37).

6. In view of (a) the prior art discussed above, (b) the multiple bases for noninfringement, and (c) the equitable estoppel resulting from Rossignol's reliance upon the Bergers' failure to respond to Rossignol's May 6, 1999 letter coupled with the Bergers' over 6 year delay in filing suit (*see, e.g.*, A141-58 and A852-64 and referenced exhibits), granting of the Bergers' motion to amend their infringement contentions would not "have allowed plaintiff to pursue a meritorious case." (Pet. 2).

CONCLUSION

For the foregoing reasons, the Petition for a Writ of Certiorari should be denied.

June 15, 2007

Respectfully submitted,

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